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MAILED
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OFFICE OF PETITIONS

In re Patent No. 6,098,247	:	
Issue Date: August 8, 2000	:	DECISION ON PETITION
Application No. 09/120,422	:	
Filed: July 22, 1998	:	
Title: PLASTIC EXTRUSION HAVING	:	
UNITARY THERMOPLASTIC RUBBER	:	
AND THERMOPLASTIC SECTIONS	:	

This is a decision in response to the petition under 37 CFR 1.378(b), filed July 12, 2012, to accept the unavoidably delayed payment of the 7.5 year maintenance fee for the above-identified patent.¹

The petition under 37 CFR 1.378(b) is **dismissed**.

If reconsideration of this decision is desired, a "Petition for Reconsideration under 37 CFR 1.378(e)" must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

¹ Petitioner submitted a PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 C.F.R. 1.378(b) (Form PTO/SB/65), accompanied by \$1,425.00 for the maintenance fee due at 7.5 years, \$2,365.00 for the maintenance fee due at 11.5 years, and a \$1,640.00 surcharge after expiration for unintentional delay. The Office notes that a petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(c) must be filed within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e). In this instance, petitioner filed the present petition on July 12, 2012, more than twenty-four months after the six-month grace period provided in 37 CFR 1.362(e). Therefore, the petition must be treated under 37 CFR 1.378(b). The current surcharge after expiration for unavoidable delay is \$700.00. Petitioner may request a refund of the overpayment of \$940.00 in writing to the address indicated on page 6 of this decision.

The patent issued on August 8, 2000. The second maintenance fee could have been paid during the period from August 8, 2007 through February 8, 2008, or with a surcharge during the period from February 9, 2008 through August 8, 2008. Accordingly, this patent expired on August 9, 2008, for failure to timely remit the second maintenance fee.

In the present petition, petitioner asserts that “[f]ailure to maintain this patent and pay the scheduled maintenance fees were unavoidable due to the firm not continuing to keep files current with [petitioner’s] knowledge.” *Petition*, 07/12/12, p. 4. Petitioner explains that he hired the law firm of Duane Morris to “file for patents, maintain records and file appropriate fees for each patents maintenance schedule.” *Id.* Petitioner states that the law firm timely paid the maintenance due at 3.5 years, but at some time thereafter the firm closed petitioner’s files without notifying him. Petitioner asserts that this resulted in the firm not paying any subsequent maintenance fees in the patent. Petitioner indicates that he contacted the firm in August of 2010, for an updated status and was told that any correspondence from the USPTO received by the firm on petitioner’s behalf had been returned to sender. Petitioner states that they subsequently sent a letter requesting the USPTO to direct all future correspondence to petitioner. A copy of the revocation of power of attorney and request for change of address dated September 22, 2010, accompanies the petition.

A petition under 37 CFR 1.378(b) to accept late payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

The petition lacks item (3) above.

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. As stated in Section 711.03(c)(II)(C)(2) of the Manual of Patent Examining Procedure:

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Section 2590(I) of the Manual of Patent Examining Procedure further explains:

As 35 U.S.C. 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. [Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).] That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. [See In re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)).] See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the

Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Initially, the Office notes that a patentee, who is required by 35 U.S.C. 41(c)(1) to pay the second maintenance fee within 7 years and six months of the patent grant or face expiration of the patent, is not entitled to any notice beyond that provided by publication of the statute. Rydeen v. Quigg, 748 F. Supp. 900, 906, 16 USPQ2d 1876 (D.D.C. 1990). The Office further notes that the Letters Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear from the record whether petitioner possessed a copy of the issued patent, petitioner's failure to read the Notice does not negate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay. See Ray v. Lehman, 55 F. 3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

When a patentee changes his correspondence address, he is responsible for promptly notifying the USPTO of the new correspondence address so that if the Office should mail a Maintenance Fee Reminder, it will be received in sufficient time to take action. If a patentee wishes to change the correspondence address of record, the patent owner must file a separate notification of the change in his correspondence address in each patent file for which he intends to receive communications from the Office signed by an appropriate party. After reviewing the revocation of power of attorney and change of correspondence address dated September 22, 2010, it appears that petitioner did not adhere to the requirements that petitioner file a separate notification of a change in correspondence address and revocation of power of attorney in each patent file for which it is intended and that it must be signed. Thus, an unsigned notification on a single paper listing plural patent number as being affected, such as that filed by petitioner on September 22, 2010, does not constitute proper notification of a change in correspondence address and revocation of power of attorney. Therefore, the Office is unable to make the changes requested until patentee files a signed revocation of power of attorney and change of correspondence address in each of the patent files listed. A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985). MPEP 711.03(c)(II)(C)(2).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The

patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol. Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). The USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130 (D. Ind. 1987) (“If that attorney somehow breached his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [the attorney’s] action or inaction with regard to the patent application. [Plaintiff] hired [the attorney] to represent him; [the attorney’s] actions must be imputed to him.”).

In this instance, petitioner was the patent owner at the time of the expiration of the patent, and therefore, he alone had an obligation to ensure the timely payment of the maintenance fee. It appears that petitioner relied solely on his attorney and the law firm for tracking the due dates and paying the maintenance fees. However, petitioner did not submit any evidence that he had an ongoing contractual agreement with the law firm to track the due dates for the second and third maintenance fee for this patent on petitioner’s behalf. Petitioner did not show that he provided any money to his attorney to cover the amount due for the second or third maintenance fees, any surcharges, and the attorney’s services for tracking the due dates of the second and third maintenance fees. Additionally, it seems that petitioner did not inform the law firm of his updated correspondence address. Petitioner indicated that attempts by the law firm to send correspondence from the USPTO to petitioner were returned as undeliverable. Thus, the record shows that petitioner did not maintain a relationship with his attorney or the law firm. Specifically, petitioner did not contact the law firm until August of 2010, after the patent had expired. Therefore, petitioner’s reliance on the law firm to track, notify, and pay the maintenance fee is not the action of a reasonably prudent person under these circumstances. Petitioner is reminded that delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay. In Re Kim, 12 USPQ2d 1595 (Comm’r Pat. 1988). Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). Moreover, the USPTO is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee. Id. Petitioner is bound by the consequences of the actions or inactions of his duly authorized and voluntarily chosen representative. Therefore, any delay caused by petitioner’s attorney or the law firm, his voluntarily chosen legal representatives, does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. at 317; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981). The burden remains on the patent owner to educate himself as to the legal requirements for maintaining a patent, to track the maintenance fee due dates, and make certain that the maintenance fees are paid in a timely manner.

The Office reminds petitioner that where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b). Additionally, a patentee's preoccupation with other matters that may have taken precedence over timely payment of the maintenance fee does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

It cannot be concluded that petitioner exercised the care or diligence that is generally used and observed by prudent and careful men in relation to their most important business. In particular, the evidence does not support a showing that petitioner took steps or acted diligently to monitor the second maintenance fee or ascertain the due date for its timely payment. Accordingly, the petition under 37 CFR 1.378(b) is **dismissed**.

Petitioner should note that if this petition under 37 CFR 1.378(b)/(e) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the maintenance fee and post-expiration surcharge. The \$400.00 petition fee for seeking further reconsideration is not refundable

Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

As a one-time courtesy, the Office will mail a copy of the decision to the address listed on the petition. However, all future correspondence with regard to this patent will be sent to the address of record until the Office receives a properly filed revocation of power of attorney and change of correspondence address.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Services Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Correspondence may also be sent electronically via the EFS-Web System.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

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